

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: August 23, 2002

Paper No. 11

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Maria Elena Velasco

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Serial No. 75/835,938

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Jill M. Pietrini of Manatt, Phelps & Phillips, LLP for  
Maria Elena Velasco.

Stephanie M. Davis, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

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Before Simms, Bucher and Bottorff, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Maria Elena Velasco (applicant), a Mexican citizen,  
has appealed from the final refusal of the Trademark  
Examining Attorney to register the mark LA INDIA MARIA for  
"pre-recorded video tapes and audiocassettes featuring  
comedic and dramatic performances and motion pictures," in  
Class 9.<sup>1</sup> The Examining Attorney has refused registration

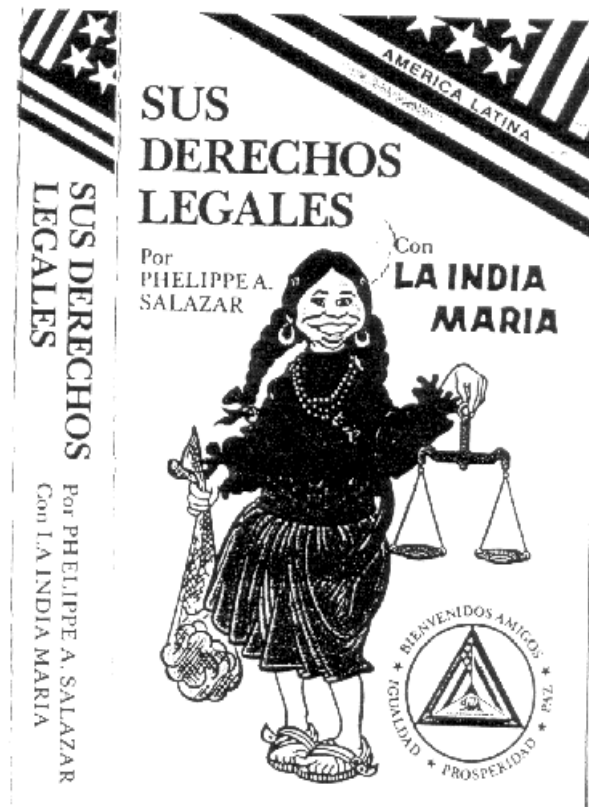
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<sup>1</sup> Application Serial No. 75/835,938, filed October 29, 1999, based upon  
allegations of use since 1979 and use in commerce since 1985.

under Sections 1, 2 and 45 of the Act, 15 USC §§ 1051, 1052 and 1127, on the basis that applicant's mark does not function as a trademark to identify and distinguish applicant's goods from those of others.<sup>2</sup> Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

Reproduced below are copies of portions applicant's specimens of record showing the manner of use of applicant's asserted mark:



<sup>2</sup> In her final refusal, the Examining Attorney incorrectly referred to applicant's mark as a "service mark" and to applicant's goods as "services."

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**TITLE: LAS DELICIAS DEL PODER  
(THE DELIGHTS OF POWER)  
ORIGINAL LANGUAGE: SPANISH  
YEAR OF PRODUCTION: 1998  
YEAR OF RELEASE: 1999  
PRODUCTION COMPANY: VLADY REALIZADORES, S.A.  
FORMAT: 35mm. COLOR THX SOUND  
LENGTH: 120 MIN.  
GENRE: COMEDY  
CAST: MA. ELENA VELASCO "LA INDIA MARIA"  
ERNESTO GOMEZ CRUZ  
HECTOR ORTEGA  
IRMA DORANTES  
FARNESIO DE BERNAL  
ADALBERTO MARTINEZ "RESORTES"  
EDITING: ANTONIO BELMONT & IVAN LIPKIES  
MUSIC: ALVARO CERVINO  
SOUND: ALBERTO CASTRO  
DIR. OF PHOTOGRAPHY: ALBERTO LEE  
EXECUTIVE PRODUCER: IVETTE E. LIPKIES  
WRITTEN BY: MA. ELENA VELASCO  
DIRECTED BY: IVAN LIPKIES**

The title on the first label is translated as "Your Legal Rights."

It is the Examining Attorney's position that, as used on the specimens of record, applicant's asserted mark LA INDIA MARIA merely identifies applicant as a cast member, performer or character appearing in applicant's videotapes and audiocassettes and not as a trademark or source indicator of applicant's goods. The Examining Attorney argues, therefore, that the public will not perceive

applicant's mark as a trademark for applicant's videotapes and cassettes.

Applicant, on the other hand, argues that her asserted mark is not merely the name of a character but also functions as a trademark because it identifies applicant, her performances and the recording of her performances (tapes and cassettes). Applicant's attorney states that applicant is a famous entertainer in Mexico and that applicant's tapes and cassettes feature applicant's dramatic and comedic performances. Counsel contends that applicant's mark appears in large print set apart from other information on the labels. According to applicant's attorney, this mark has come to be associated as identifying not only applicant as a performer but also the source of applicant's tapes and cassettes that feature these performances. While applicant agrees that a term is not registrable if it fails to identify the origin of goods or services, applicant contends that her mark functions as a trademark to indicate the "brand" of performances on the tapes and cassettes as well indicating the name of a character. Applicant compares her mark to several third-party registered marks listed in her brief--JOHNNY CARSON

and BATMAN.<sup>3</sup> Applicant requests that the Board reverse the refusal or, alternatively, remand this case to the Examining Attorney because applicant intends to submit additional specimens.<sup>4</sup>

It is settled that not all words, designs, symbols or slogans used in connection with the sale or advertising of goods or services function as trademarks or service marks. That is to say, a term does not function as a trademark or service mark unless it is used in a manner which clearly projects to purchasers a single source. *In re Chicago Reader Inc.*, 12 USPQ2d 1079, 1080 (TTAB 1989); and *In re Morganroth*, 208 USPQ 284 (TTAB 1980).

As the Examining Attorney has recognized, the name of a character may be registrable as a trademark if the name is used on or in connection with the goods in such a manner as to identify applicant's goods and distinguish them from those of others. *In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394 (CCPA 1982); and *In re Caserta*, 46 USPQ2d 1088, 1090 (TTAB 1998). The issue is whether the name is used in

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<sup>3</sup> Applicant has not submitted copies of these registrations.

<sup>4</sup> Applicant's alternative request for remand in her brief is inappropriate. If an applicant wishes to introduce additional evidence after an appeal has been filed, the applicant may file a separate written request with the Board to suspend the appeal and remand the application for further examination. See Trademark Rule 2.142(d). In addition, the request must include a showing of good cause therefor (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to the appeal), and be accompanied by the additional evidence sought to be introduced. See TBMP § 1207.02. The brief is not the appropriate place for requesting remand.

such a manner that it is likely to be perceived as a trademark for applicant's goods. The determination of whether an asserted mark is being used in the manner of a trademark to identify and distinguish one's goods is made on the basis of the specimens and other evidence of record that reflects the manner of use. *In re Caserta, supra*, at 1090 n. 4; *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053, 1056 (TTAB 1991); and *In re Chicago Reader Inc., supra*.

Here, we are in agreement with the Examining Attorney that applicant's asserted mark is and will be perceived only as identifying the principal character appearing in applicant's tapes and cassettes, and not as a trademark indicating origin of the goods in applicant. In this regard, the specimens show the title of the tape followed by the wording "Con LA INDIA MARIA" ("With THE INDIAN MARIA"). The name LA INDIA MARIA is shown in close proximity to the depiction of a woman carrying a bag in one hand and the scales of justice in the other. In addition, it is clear from applicant's specimens that LA INDIA MARIA is the name of a cast member. The fact that this name appears fairly prominently on the labels of applicant's tapes and cassettes is not determinative. Because the asserted mark will be perceived merely as the name of the

main character or actor appearing in applicant's tapes and cassettes and not as an indication of source of the goods, the asserted mark is not registrable. See, for example, *In re Caserta, supra* (FURR-BALL FURCANIA unregistrable because it is merely part of a title and identifies the principal character in applicant's children's books and periodical publications); and *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984)(THE LITTLES, as used in the title of each book, would be viewed as identifying the main character in the book).

Finally, the third-party registrations listed in applicant's brief are irrelevant. Not only do we not have copies of those registrations in the record, but, in any event, the determination of whether the instant mark functions as a mark for applicant's goods must be made on the basis of the manner of use shown in this record.

Decision: The refusal of registration is affirmed.